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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/891,005	06/25/2001	Michael Shawn Giffin	SNY-P4260	9424

24337 7590 08/07/2006

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EXAMINER	
NGUYEN, QUANG N	
ART UNIT	**PAPER NUMBER**
2141	

DATE MAILED: 08/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/891,005	GIFFIN ET AL.	
	Examiner	Art Unit	
	Quang N. Nguyen	2141	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *24 July 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3-20 and 29-31* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-20 and 29-31* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *25 June 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Detailed Action

1. This Office Action is in response to the Amendment filed on 07/24/2006. Claim 1 has been amended. Claims 2 and 21-28 have been cancelled. Claims 1, 3-20 and 29-31 are presented for examination.

As requested by the Applicant's Representative, Mr. Jerry A. Miller, Reg. No. 30,779, the Finality of the Previous Final Rejection has been withdrawn (since claims 9-20 and 29-30 remained unamended since the last Office Action mailed on 01/31/2006), hence, the Previous Final Rejection mailed on 06/26/2006 would be considered as a Non-Final Rejection.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 1, 3-20 and 29-31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads (US 6,311,214), in view of Milton (US 2002/0059120 A1) claiming the benefit of the US Provisional Application No. 60/209,838 filed on 06/06/2000.

4. As to claim 1, **Rhoads** teaches a method carried out at a music file storage data center, comprising:

receiving from a first customer a request to store a music file representing a musical selection *(receiving a user request to download/store the music file to a predetermined location associated with the user)* **(Rhoads, col. 46, lines 24-34)**;

storing the music file representing the musical selection for access by the first customer, wherein the storing is carried out as a response to the request to store the music file *(the music filed downloaded from the clearinghouse can be stored at a remote web site, i.e., stored at the predetermined location associated with the user)* **(Rhoads, col. 46, lines 28-45)**;

mapping the first customer to the music file so that the first customer can have access to the music file *(the music file can be stored at a web site protected with a user-set password and can be downloaded to the user's computer whenever it is convenient)* **(Rhoads, col. 46, lines 32-34)**;

receiving a request from any of the mapped customers for playback of the music file *(the music file can be stored at a web site protected with a user-set password and in response to the request for playback, the music file can be downloaded to the user's computer whenever it is convenient)* **(Rhoads, col. 46, lines 32-34)**; and

transmitting the music file to the customer that sent the request for playback, using wireless transmission, as a streaming music file *(the personal music file/library can be equipped with wireless capabilities adapted to provide music to the user's*

playback devices such as MP3 player by short-range wireless broadcast) **(Rhoads, col. 46, lines 35-53)**.

However, **Rhoads** does not explicitly teach mapping at least one other customer who wishes to have access to the music file representing the musical selection.

In an analogous art, **Milton** teaches a method and apparatus for creating and maintaining a virtual inventory of media contents in a distributed network, wherein the media contents *(such as songs on a particular soundtrack of a particular artist)* can be purchased, registered, distributed, stored, shared and accessed using a plurality of web enabled devices over the Internet or World Wide Web **(Milton, paragraph [0019], supported by 3rd paragraph, page 1 of Milton US Provisional Application No. 60/209,838 filed on 06/06/2000)**. **Milton** also teaches using the information on the virtual inventory receipt *(which represents the media content purchased by the user)*, the Media Content Administrator 160 will generate a virtual inventory unit *(not a physical copy of the purchased media content to be sent to the user)* serving as an authorization to have access to the purchased media content via the media access providers by the user, wherein the Media Content Administrator 160 can limit the generations of virtual inventory units to a "Finite" distribution parameter, for example, 100,000 copies for a particular media content or "Infinite", i.e., unlimited copies for a particular media content *(i.e., mapping at least one other customer who wishes to have access to the music file representing the musical selection)* **(Milton, paragraphs [0056-0057] and [0070], supported by 3rd paragraph, page 1 and 4th-5th paragraphs, page 4 of Milton US Provisional Application No. 60/209,838 filed on 06/06/2000)**.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the teachings of **Rhoads** and **Milton** to include mapping at least one other customer who wishes to have access to the music file representing the musical selection since such methods were conventionally employed in the art to provide a virtual inventory of goods, e.g., media contents which can be purchased, registered, distributed, stored, shared and accessed using a plurality of web enabled devices over the Internet or World Wide Web **(Milton, paragraph [0019])**.

5. As to claim 3, **Rhoads-Milton** teaches the method of claim 1, further comprising paying a royalty for use of the music file *(the clearing house charges the user a nominal fee)* **(Rhoads, col. 46, lines 24-25 and Milton, paragraph [0050])**.

6. As to claim 4, **Rhoads-Milton**, teaches the method of claim 1, further comprising charging each of the customers mapped to the music file a fee for storage of the music file *(subscription-based payment, e.g., monthly, quarterly, yearly)* **(Milton, paragraph [0050])**.

7. As to claim 5, **Rhoads-Milton** teaches the method of claim 1, further charging the customer that sent request for playback a fee for transmitting the music file to the customer that sent the request for playback *(access-based payment, payment based on the number of times the virtual inventory unit is accessed)* **(Milton, paragraph [0050])**.

8. As to claim 6, **Rhoads-Milton**, teaches the method of claim 1, further comprising uploading the music file from the first customer prior to the storing *(the predetermined location is a personal music library maintained by the user, wherein the library can take the form of a hard-disk or memory array in which the user customarily stores music, since the library can be remotely sited, hence the customer has to upload the music file prior to store it at the remotely sited central location)* **(Rhoads, col. 46, lines 35-45)**.

9. As to claims 7-8, Rhoads-Milton teaches the method of claim 1, further comprising obtaining the music file from a commercial music source prior to the storing *(the clearing house charges the user a nominal fee prior to downloading the music to be stored at the predetermined location associated with the user)* **(Rhoads, col. 46, lines 24-27 and Milton, paragraphs [0027] and [0050])**.

10. Claims 9-14 are corresponding electronic storage medium claims of method claims 1 and 4-7; therefore, they are rejected under the same rationale.

11. Claims 15-20 are corresponding data center claims of method claims 1 and 4-7; therefore, they are rejected under the same rationale.

12. Claim 29 is a corresponding combination method claim of method claims 1 and 3-5; therefore, it is rejected under the same rationale.

13. Claim 30 is a corresponding data center claim of method claim 29; therefore, it is rejected under the same rationale.

14. As to claim 31, **Rhoads-Milton** teaches the method claim of claim 1, with the addition of "determining that at least one other customer who wishes to have access to the musical selection" *(**Milton** teaches a particular media content can be set an "Infinite" or a "Finite" distribution parameter such as 100,000 copies, so if multiple users are to purchase, i.e., multiple users wish to have access to, the same particular media content, a purchase request will be received from a registered customer and hence, a determination will be made and a virtual inventory unit will be generated to serve as an authorization to have access to the purchased media content via the media access provider by the user)* **(Milton, paragraphs [0056-0057] and [0070])**.

Response to Arguments

15. In the Remarks, Applicants argued in substance that

(**A**) "It is noted that the Milton US 2002/0059120 A1 publication does not, per se, constitute prior art to the present application".

As to point (**A**), Examiner respectfully disagrees with the Applicants that the Milton US 2002/0059120 A1 publication does not constitute prior art to the present application because the Milton US 2002/0059120 A1 publication does claim the benefit of the Milton US Provisional Application No. 60/209,838 filed on 06/06/2000 and the disclosure of the Milton US Provisional Application No. 60/209,838 (page 1 – page 4) does support the Milton US 2002/0059120 A1 publication used in the rejection.

Hence, the Milton US 2002/0059120 A1 does constitute prior art to the present application.

(**B**) "Clearly, Milton Provisional explicitly teach away from a customer storing content or requesting storage of content (by citing *"Content is **never** ... stored by a user"*).

As to point (**B**), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, Examiner respectfully submits that the language cited in the quotation from the Milton Provisional Application "The textual, binary, audio, video, or other Content represented by the Units is not actually contained within the Units, and such Content is never permanently transferred to or stored by a user of the Units in connection with the System" means "The textual, binary, audio, video, or other Content represented by the Units is not actually contained within the Units, and such Content is never permanently transferred to or stored by a user ***(at the user computer/site)*** of the Units in connection with the System" *(emphasis added)*.

Since the system of Milton offers a controlled, monitored division of on-demand, streaming, or real-time access to a Master copy, or copies of Content stored on the remote server or on a storage media as designated by the Content Owner, after successful Account creation and using the generated virtual inventory Units which are comprised of two components being a Content ID and a Usage Permit, the system of Milton allows a user to: **Add**/Delete **virtual inventory Unit(s) to**, and activate virtual media/Content on, **his/her personal collection** on Account via the validation process *(i.e., receiving a request from a customer to store a music file and storing the file for the customer)*, and Access, on-demand, the Content upon request as the user commands such requests through the Users graphical or hardware interface located on the Primary Device, etc. **(pages 1-3 of the Milton US Provisional Application)**.

Clearly, Milton Provisional Application does not teach away from a customer storing content or requesting storage of content.

16. Applicant's arguments as well as request for reconsideration filed on 07/24/2006 have been fully considered but they are not deemed to be persuasive.

17. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quang N. Nguyen whose telephone number is (571) 272-3886.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's SPE, Rupal Dharia, can be reached at (571) 272-3880. The fax phone number for the organization is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quang N. Nguyen
Patent Examiner
AU - 2141

RUPAL DHARIA
SUPERVISORY PATENT EXAMINER